

## REMARKS

The Office dated November 15, 2003, has been received and reviewed.

Claims 12-16 remain pending and under consideration in the above-referenced application. Each of claims 12-16 stands rejected.

New claims 24-37 have been added.

Reconsideration of the above-referenced application is respectfully requested.

## Withdrawal of Finality of Office Action

The cover sheet of the Office Action dated December 15, 2003, indicates that the Office Action is "Final." As this is the first Office Action mailed following the filing of a Request for Continued Examination in the above-referenced application, it is respectfully submitted that the "Final" status of the outstanding Office Action is improper and requested that the finality thereof be withdrawn.

## Rejections Under 35 U.S.C. § 102

Claims 12, 14, and 16 stand rejected under 35 U.S.C. § 102 for reciting subject matter which is purportedly anticipated by the disclosure of U.S. Patent 5,327,652 to Balback (hereinafter "Balback").

Balback describes a hand-held apparatus 10 for notching seams in fabrics and other materials that are used in sewing. That apparatus 10 includes two opposed members, or jaws 18 and 19, that are configured to receive and oppose *two* cutting assemblies 22 and 26. The two cutting assemblies are to be used *together* to cut notches into fabrics or other materials. FIGs. 2 and 3; col. 5, lines 35-62. The thickness of each cutting assembly 22, 26 is about half of the diameter thereof. *See* FIG. 3. Thus, cutting assemblies 22 and 26 do not appear to be planar.

In order to secure such bulky structures to jaws 18 and 19, each cutting assembly 22, 26 includes a threaded aperture therethrough, which is configured to receive a complementarily threaded connector 28, 30, such as a bolt. As shown in FIG. 3 of Balback, each threaded aperture extends completely through its respective cutting assembly 22, 26. Each connector 28, 30 also passes through the corresponding jaw 18, 19 of the hand-held apparatus 10. FIGs. 2 and 3;

col. 6, lines 1-9. Thus, the surfaces of both the cutting assemblies 22, 26 and the jaws 18, 19 of the hand-held apparatus 10 described in Balback are interrupted.

Additional interruptions, in the form of recessed guide portions 36, 40, are included in the interior surfaces of jaws 18, 19 of the hand-held apparatus 10 described in Balback. *See FIG. 3, col. 6, lines 10-20.* Guide portions are configured to receive complementary protruding guide portions 38, 42 of cutting assemblies 22, 26.

Independent claim 12, as amended and presented herein, is drawn to an apparatus for forcing a die through a sheet of material. The apparatus of amended independent claim 12 includes, among other things, a first member, a second member, and handles associated with the first and second members. The first member includes an uninterrupted, planar die receiving surface and a die retaining element. The die retaining element is configured to secure a planar surface of a substantially planar die to the die receiving surface. The second member includes an uninterrupted, planar sheet supporting surface. The handles facilitate movement of at least one member of the first and second members toward the other member.

Since jaws 18, 19 of the hand-held apparatus 10 of Balback include aperture therethrough, as well as recessed guide portions 36, 40, it is respectfully submitted that Balback does not include any express or inherent description of "an uninterrupted, planar die receiving surface . . .," as required by amended independent claim 12.

In addition, neither cutting assembly 22 nor cutting assembly 26 of the hand-held apparatus 10 of Balback includes "a planar surface," as required by amended independent claim 12. Rather, cutting assemblies 22, 26 include guide portions 38, 42 protruding from the surfaces thereof.

It is also respectfully submitted that Balback does not expressly or inherently describe an apparatus that includes a sheet supporting surface. Rather, the hand-held apparatus 10 of Balback includes two jaws 18 and 19 that carry cutting assemblies 22, 26 between which a sheet of fabric is to be held. *See, e.g., col. 6, lines 26-29.*

Even assuming, *arguendo*, that Balback does describe that the apparatus 10 thereof includes a sheet supporting surface, it is submitted that Balback does not expressly or inherently describe that any such sheet supporting surface of the apparatus 10 thereof is "uninterrupted" and

“planar,” as required by amended independent claim 12. Neither jaw 18 nor jaw 19 of the apparatus 10 described in Balback is substantially planar. Rather, as FIG. 3 of Balback clearly shows, jaws 18, 19 both include well portions 20, 24 which are configured to receive cutting assemblies 22, 26. *See also* col. 5, lines 39-41 and 46-49. Well portions 20, 24 are interrupted by apertures that are configured to receive connectors 28, 30.

Moreover, neither cutting assembly 22 nor cutting assembly 26 includes an exposed surface that could be considered to be substantially planar. Instead, the surfaces of cutting assemblies 22, 26 are interrupted by patterns of protruding cutting elements 34, as well as recesses that are configured to receive the cutting elements 34. *See* FIG. 3; col. 5, lines 63-68.

Furthermore, since cutting assemblies 22, 26 of the hand-held apparatus 10 of Balback are configured to cut through thick fabrics, such as leather (col. 7, lines 26-28), it is respectfully submitted that neither of them is “substantially planar.” Thus, neither of jaw 18, 19 is configured to receive a substantially planar die, as required by independent claim 12. Rather, in order to cut through thick fabrics such as leathers, the cutting elements 34 and corresponding recesses of cutting assemblies 22, 26 must respectively protrude from and be depressed within the cutting assemblies significant distances (*i.e.*, a distance that is at least equal to the thickness of the thick fabric), which distances would certainly render the cutting assemblies 22 and 26 nonplanar. In fact, the cutting assemblies 22, 26 that are illustrated in FIG. 3 have thicknesses which appear to be equal to about half of their diameters.

For these reasons, it is respectfully submitted that Balback does not anticipate each and every element recited in amended independent claim 12. Therefore, under 35 U.S.C. § 102(b), amended independent claim 12 recites subject matter which is allowable over that described in Balback.

Claims 14 and 16 are both allowable, among other reasons, for depending from claim 12, which is allowable.

For these reasons, it is respectfully requested that the 35 U.S.C. § 102(b) rejections of claims 12, 14, and 16 be withdrawn and that each of these claims be allowed.

**Rejections Under 35 U.S.C. § 103(a)**

Claims 13 and 15 have both been rejected under 35 U.S.C. § 103(a).

M.P.E.P. § 706.02(j) sets forth the standard for a rejection under 35 U.S.C. § 103(a):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Secondary considerations of nonobviousness include "commercial success, long felt but unsolved needs, failure of others, etc." M.P.E.P. § 2141, quoting *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

Balback in View of Benson

Claim 13 has been rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over that taught in Balback, in view of teachings from U.S. Patent 5,660,105 to Benson et al. (hereinafter "Benson").

The teachings of Balback have been summarized above.

Benson teaches a punching or embossing tool 10 that includes dies 20 and 22 which are configured to be opposed and biased against one another by compression members 24 and 26. FIG. 1; col. 3, lines 44-48. Each die 20, 22 includes an octagonal base 54, 64 and an insertion member 50, 60 protruding from a substantially planar surface of the octagonal base 54, 64. FIGs. 3 and 4; col. 4, lines 15-44. Each protruding insertion member 50, 60 also has an octagonal shape. *Id.*

Each compression member 24, 26 includes an elongate die receiving cavity 24a, 26a within which a base 54, 64 of a die 20, 22 is to be slidingly disposed and retained. FIG. 1; col. 3, lines 49-51. The protruding insertion member 50, 60 of each die 20, 22 extends through a

receiving slot 40, which communicates with the cavity 24a, 26a, as the base 54, 64 of that die 20, 22 is slid through the cavity 24a, 26a. An end of each receiving slot 40 has a half-octagonal profile 42 which corresponds to the octagonal shape of the insertion members 50, 60 of the dies 20, 22 and is, thus, configured to receive a protruding insertion member 50, 60 and retain a desired orientation thereof. FIGS. 3 and 4; col. 4, lines 8 and 9.

A retainer magnet 44 is disposed within each die receiving cavity 24a, 24b to hold the dies 20, 22 therein. FIGS. 3 and 4; col. 4, lines 10-44. The retainer magnets 44 also have a half-octagonal profile, which complements the octagonal shapes of the bases 54, 64 of the dies 20, 22. Col. 4, lines 10-14. The retainer magnets 44, including the magnetic fields generated thereby and their half-octagonal profiles, in combination with the complementary shapes of the bases 54, 64 of the dies 20, 22 and the die receiving cavities 24a, 26a and the complementary shapes of the ends of the receiving slots 40 and the insertion members 50, 60 of the dies 20, 22, hold the dies 20, 22 in a desired position within the die receiving cavities 24a, 26a.

Claim 13 recites that the die retaining element of claim 12, which is configured to receive a substantially planar die, is magnetic.

Claim 13 is allowable, among other reasons, for depending from claim 12, which is allowable.

It is also respectfully submitted that there are several additional reasons that a *prima facie* case of obviousness has not been established against claim 13.

#### *Primary Indicia of Nonobviousness*

First, neither Balback nor Benson, taken either separately or together, teaches or suggests each and every element of independent claim 12, from which claim 13 depends. In particular, Balback and Benson both lack any teaching of a sheet support surface, that a sheet supporting surface may be substantially planar, and of a die retaining element which is configured to receive a substantially planar die.

Second, one of ordinary skill in the art would not have been motivated by the teachings of Balback or Benson or by the knowledge that was generally available in the pertinent art before

the filing date of the above-referenced application, to have combined the teachings of Balback with those of Benson in the manner that has been asserted. In particular, the apparatus 10 of Balback includes cutting assemblies 22, 26 that are held in place within respective jaws 18, 19 by way of bolts (*i.e.*, connectors 28, 30). In contrast, the apparatus 10 of Benson includes dies 20, 22, cavities 24a, 24b, and magnets 44 that have complex, complementary shapes to hold the dies 20, 22 at a desired position and in a desired orientation. These complexities would prevent the substitution of a magnet for the bolt type connector 28, 30 of Balback.

Third, it is respectfully submitted that the complex shapes of the dies 20, 22 of the apparatus 10 of Benson teach away from the simpler cutting assembly 22, 26 designs of Balback, as well as from the substantially planar dies with which the apparatus of claim 13 is configured to be used.

Fourth, a magnet of the shape taught in Benson (half-octagonal) would not be useful to secure the cutting assemblies 22, 26 of Balback to the jaws 18, 19 of the apparatus 10 taught in Balback. Thus, one of ordinary skill in the art would have had no reason to expect the asserted combination of teachings from Balback and Benson to be successful.

#### *Secondary Considerations*

Additionally, the long felt need in the art for an apparatus of the type recited in claim 13, as well as the commercial success resulting from the fulfillment of such a long felt need provide additional evidence of the nonobviousness of the apparatus to which claim 13 is drawn.

In particular, since being introduced into the market in March 2002, with initial delivery occurring thereafter, several thousand apparatus that fall within the scope of claim 13 have been sold by QuicKutz, Inc., the assignee of the above-referenced application. Since March, 2002, twenty-seven thousand, seven hundred thirty-six (27,736) such apparatus were sold by QuicKutz. They currently retail for \$99.99 per unit, as evidenced by QuicKutz's website — [www.quickutz.com](http://www.quickutz.com), meaning that over \$ 2,750,000.00 worth of these devices have been sold in the first two years of availability. The following table provides even more detail for this time period:

<b>Year - Month</b>	<b>Units Sold</b>
2002 - March	9
April	86
May	105
June	269
July	349
August	650
September	776
October	1,045
November	920
December	1,168
2003 - January	1,212
February	1,303
March	1,892
April	1,115
May	3,284
June	1,094
July	1,403
August	1,129
September	1,738
October	2,158
November	1,298
December	1,928
2004 - January	1,363
February	1,442

The commercial success of the apparatus recited in claim 13, which is obviously due, at least in part, to a long felt need for such an apparatus, clearly illustrates that the subject matter to which claim 13 is directed would not have been obvious to one of ordinary skill in the art at the time the above-referenced application was filed.

For these reasons, it is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established against claim 13 and, thus, that claim 13 recites subject matter which is allowable over the teachings of Balback and Benson.

Balback in View of Sabin

Claim 15 stands rejected under 35 U.S.C. § 103(a) for purportedly reciting subject matter which is unpatentable over that taught in Balback, in view of the teachings of U.S. Patent 5,172,622 to Sabin (hereinafter “Sabin”).

The teachings of Balback have been summarized above.

Sabin teaches a table-top die cutting apparatus 10 that includes a base 20 that is configured to support a sheet of paper or other material to be die-cut, a frame 18 extending upwardly from the base 20 and supporting a die receiving element 14, and a “shifting mechanism” 16 held in place by the frame 18 and associated with the die receiving element 14. Figs. 1 and 4; col. 3, lines 29-39. A pad 22 is located on the base 20. *Id.* The shifting mechanism 16 is basically a handle that, when moved, forces the die receiving element 14 downward toward the base 20 of the die cutting apparatus 10 and, thus, forces the cutting edges of a die 12 through a sheet 27 of paper or other material supported by the base. *Id.*

Claim 15 recites that at least a portion of the substantially planar sheet supporting member of the apparatus of claim 12 includes a cushioning element.

Claim 15 is allowable, among other reasons, for depending from claim 12, which is allowable.

*Primary Indicia of Nonobviousness*

In addition, it is respectfully submitted that a *prima facie* case of obviousness has not been established against claim 15 because one of ordinary skill in the art would not have been motivated to combine the teachings of Balback and Sabin in the manner that has been asserted. More specifically, Balback teaches a hand-held apparatus for cutting patterns into thick fabrics, such as leather, whereas the apparatus of Sabin is a table-top apparatus for cutting designs into thin sheets of material, such as papers. Moreover, the apparatus 10 of Balback, which includes two opposed cutting assemblies 22, 26, lacks a sheet supporting surface with which a pad 22 such as that taught in Sabin would be useful.

It is also respectfully submitted that one of ordinary skill in the art would have no reason to expect that incorporation of the pad 22 of Sabin into the apparatus 10 of Balback would be

successful. To the contrary, since the apparatus 10 of Balback includes cutting assemblies 22, 26 that are configured to be opposed and to cut through a thick piece of fabric from opposite surfaces thereof, the application of a pad 22 of the type taught in Sabin to the cutting surface of one of the cutting assemblies 22, 26 of Balback would merely interfere with the intended operation of the apparatus 10 taught in Balback; *i.e.*, it would not work as intended.

For these reasons, it is respectfully submitted that the asserted combination of teachings from Balback and Sabin does not support a *prima facie* case of obviousness against claim 15. It is, therefore, respectfully submitted that, under 35 U.S.C. § 103(a), claim 15 is allowable over the teachings of Balback and Sabin.

In view of the foregoing, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 13 and 15 be withdrawn.

#### New Claims

New claims 24-37 have been added.

New claim 24 depends from independent claim 12 and recites that the die receiving surface of the first member of an apparatus for forcing a die through a sheet of material is “unbounded.” As the description of Balback is limited to a hand-held apparatus 10 that includes jaws 18, 19 with wells 20, 24 formed therein, and wells 20, 24 are bounded by sidewalls, it is respectfully submitted that Balback does not anticipate or render obvious the subject matter recited in claim 24.

New claim 25 is an independent claim. New independent claim 25 is directed to an apparatus that includes many of the elements of independent claim 12, prior to the amendment thereof presented herein, with the additional limitation that the first member of the claimed apparatus include an “unbounded die receiving surface.” Again, as Balback does not describe, teach, or suggest that either of the jaws 18, 19 thereof may include an unbounded die receiving surface, it is respectfully submitted that Balback does not anticipate or render obvious the subject matter recited in new independent claim 25.

New claims 26-30 depend from new independent claim 25, with new claims 27 and 28 reciting limitations that are present in amended independent claim 12.

New claim 31 is also an independent claim. New independent claim 31 is drawn to an apparatus that includes a first member, a second member, and handles associated with the first and second members. The first member includes “an uninterrupted, planar die receiving surface.” As Balback teaches that jaws 18, 19 of the hand-held apparatus 10 disclosed therein comprise wells 20, 24, have apertures formed therethrough, and have guide portions 36, 40 recessed therein, it is clear that Balback lacks any description, teaching, or suggestion that either jaw 18, 19 thereof may be uninterrupted or planar. It is, therefore, respectfully submitted that new independent claim 31 recites subject matter which is neither anticipated nor rendered obvious by the disclosure of Balback.

New claims 32-37 depend from new independent claim 31, with claims 32 and 34 including limitations that appear in amended independent claim 12, and claim 33 including the additional “unbounded” limitation of new claims 24 and 25.

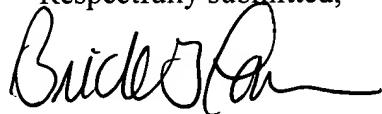
It is respectfully submitted that none of new claims 24-37 introduces new matter into the above-referenced application, as each recites subject matter which has basis in the as-filed specification and drawings of the above-referenced application.

Accordingly, entry and allowance of new claims 24-37 are respectfully requested.

### CONCLUSION

It is respectfully submitted that each of claims 12-16 and 24-37 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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